



UNITED STATES PATENT AND TRADEMARK OFFICE

Am

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,556	03/28/2001	Yasuyuki Fujikawa	1614.1158	9443
21171	7590	04/05/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			HUYNH, THU V	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,556

Applicant(s)

FUJIKAWA, YASUYUKI

Examiner

Thu V Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 12/08/2004 to application filed on 03/28/2001 which has foreign priority filed on 10/31/2000.
2. Claims 1 and 6 is amended.
3. Claims 1-13 are pending in the case. Claims 1, 6 and 9 are independent claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-3, 6 and 7 remain rejected under 35 U.S.C. 102(e) as being anticipated by Chadha, US 6,061,698, patented 05/2000.** Regarding independent claim 1, Chadha teaches a recording medium readable by a computer, tangibly embodying a program executable by the computer to make a modified document based on an original document, wherein said original

Art Unit: 2178

document consists of a plurality of areas and is stored in a memory device, a part or all of said plurality of areas being provided with identification, (Chadha, abstract, col.1, line 51 – col.2 line 6; col.4; lines 16-45; and col.7, lines 24-28; a computer readable program used to make a modified document (linked document 50) based on an original document (markup 38), wherein said original document is stored in a memory device (visual tool 10), and consists plurality of dynamic data in comment statements, said a part or all of dynamic data being provided with special tag identifiers), by:

- receiving an instruction (Chadha, figures 2 and 3; col.5, lines 28-41; program (linkage tool 40) searches comment statement to identify special tags in said markup document. This is inherently discloses an instruction for searching must be received in order to search the markup document);
- causing a document modifying apparatus to identify one or more areas in the original document specified by the identification in said instruction (Chadha, figures 2 and 3; col.5, lines 28-41; searching comment statement to identify special tags in the markup document); and
- causing the document modifying apparatus to modify said identified one or more areas in a manner defined by said instruction in order to make a modified document (Chadha, figures 2 and 3; col.3, line 42 – col.4, line 20, modifying the document into a linked document 50).

Regarding claim 2, which is dependent on claim 1, Chadha teaches the limitations of claim 1 as explained above. Chadha teaches wherein said document is in a fixed format

Art Unit: 2178

including a comment, and said identification is included in the part or all of said plurality of areas as the comment (Chadha, col.4, line 39 – col.5, line 39).

Regarding claim 3, which is dependent on claim 1, Chadha teaches the limitations of claim 1 as explained above. Chadha teaches wherein said fixed format is an HTML (Hypertext Markup Language) (Chadha, col.1, line 65 – col.2, line 6 and col.4, line 54-64).

Regarding independent claim 6, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale. The limitation of “means for storing said plurality of areas to a memory” must be included, since the markup language is searched and displayed to the user, areas in the markup language must be store in a memory for searching and displaying.

Regarding dependent claim 7, the claim incorporates substantially similar subject matter as claim 2, and is rejected along the same rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the

Art Unit: 2178

time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 4 remain rejected under 35 U.S. C. 103(a) as being unpatentable over Chadha as applied to claim 1 above and further in view of Hobbs, US 6,523,022, filed 07/1999.

Regarding claim 4, which is dependent on claim 1, Chadha teaches the limitations of claim 1 as explained above. Chadha does not explicitly disclose wherein an area of the document includes another area by taking a nesting structure.

Hobbs teaches web page document includes nesting tag so that an area includes another area (Burch, col.20, line 17 – col.21, line 35).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined to Hobb's nested HTML tag and Chadha's web page to provide a nested structure for the web page in markup language document (HTML), since such nested HTML tag would have facilitated the layout information for the web page. It is also noted that nesting structure in HTML for formatting information was well known in the art at the time the invention was made.

7. Claim 5 and 8 remain rejected under 35 U.S. C. 103(a) as being unpatentable over Chadha as applied to claims 1 and 6 above and further in view of Homer et al., "Instant HTML", copyright 1997, pages 76-107.

Regarding claim 5, which is dependent on claim 1, Chadha teaches the limitations of claim 1 as explained above. Chadha does not explicitly disclose wherein said program including

Art Unit: 2178

the step of inputting a name of an area, a start line of the area and the number of lines included in the area as the identification.

Homer teaches “src” to identify an image name; “hspace” to identify a start line of the image image; “width” and “height” to identify the number of lines include in the image area (Homer, pages 76 and 78). Homer also teaches “coords” to identify a start position of the image (Homer, page 101).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Homer’s image area identification into Chadha to inputting such identification into the web document, since such identification would have used to an area that used to add or edit the content of the document as Chadha disclosed in col.1, lines 56-59.

Regarding dependent claim 8, the claim incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

8. Claims 9-12 remain rejected under 35 U.S. C. 103(a) as being unpatentable over Chadha as applied to claim 1 above and further in view of Popp et al., US 2002/0133637 A1, filed 08/1995.

Regarding independent claim 9, the claim incorporates substantially similar subject matter as claims 1 and 6, and is rejected along the same rationale. Chadha teaches a storage unit (Chadha, col.4, lines 22-25). Chadha does not explicitly disclose a document transmitting unit

Art Unit: 2178

transmitting said document to a network. However, Chadha teaches document, such as HTML embeds dynamic data is sent over a network (Chadha, col.1, lines 11-29).

Popp teaches transmitting web page document to a client via WWW (Popp, page 1, paragraph 13 and page 4, paragraph 54; transmitting a web document to display on client's browser through WWW).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Popp's transmitting feature into Chadha to include a document transmitting unit to transmit web page document to a network, since transmitting unit allows the web page document to be sent to clients on the Internet.

Regarding claim 10, which is dependent on claim 9, Chadha and Popp teach the limitations of claim 9 as explained above. Refer to the rationale relied to reject claim 9 the limitations of "a client unit including a displaying unit, receiving said document from the network, and displaying said document on said displaying unit" is included. The rationale is incorporated herein.

Regarding claim 11, which is dependent on claim 9, Chadha and Popp teach the limitations of claim 9 as explained above. Chadha teaches said instruction is inputted from an application utilizing said document, to said plurality of areas specified by the identification, by said instruction inputting unit (Chadha, col.5, line 29 – col.6, line 20 and col.6, line 7 – col.7, line 9).

Art Unit: 2178

Regarding dependent claim 12, the claims incorporate substantially similar subject matter as claim 2 and is rejected along the same rationale.

9. **Claim 13 remain rejected under 35 U.S. C. 103(a) as being unpatentable over Chadha in view of Popp as applied to claim 9 above and further in view of Homer et al., “Instant HTML”, copyright 1997, pages 76-107**

Regarding dependent claim 13, which is dependent on claim 9, the claims incorporate substantially similar subject matter as claim 5 and is rejected along the same rationale.

Response to Arguments

10. Applicant's arguments filed 12/08/2004 have been fully considered but they are not persuasive.

Applicants argue that with respect to claim 1 and 6 that, “In Chadha, instructions are embedded in an original document in form of a script language” and “in the present invention, such kinds of instruction are not embedded in an original document. In other words, an original document is separated from a program which defines how to make a modified document”.

This is not persuasive. First, the claim language does not address what applicants argue. The features upon which applicant relies, such as “instruction are not embedded in an original document” and “an original document is separated from a program which defines how to make a modified document” are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, Chadha’s instructions

Art Unit: 2178

are from the program to search the document, such instructions are not embedded in the original document as explained in the rejection above.

Applicants argue that with respect to claims 4, 5, 8-13 “fail to support the obviousness of those combinations”.

This is not persuasive. The benefits of combination prior arts in the record are addressed in the rejection above.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

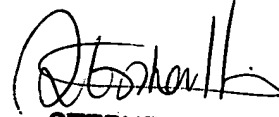
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

Art Unit: 2178

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
March 24, 2005


STEPHEN HONG
SUPERVISORY PATENT EXAMINER